

Application No. 10/734,671
Amendment dated February 9, 2009
Reply to Office Action dated November 7, 2008

REMARKS

**Reconsideration And Allowance
Are Respectfully Requested.**

Claim 49 is currently pending. Claims 1-48 have been canceled by way of prior amendments. Claim 49 has been amended. No new matter has been added. No new claims have been added. Reconsideration is respectfully requested.

In view of the amendment to claim 49, all of the objections and rejections set forth in numbered paragraphs 3-24 of the Office Action dated November 7, 2008 are deemed to be moot as amended claim 49 is clearly supported by original specification and entitled to the September 16, 1994 priority date. The amendments are being made to further prosecution and should not be construed as Applicant's acquiescence to the Examiner's assertion that the language of claim 49 is not entitled to the September 16, 1994 priority date. As such, the amendments should not prejudice Applicant's right to pursue such language in future amendments or applications.

Claim 49 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,567,689 to Burbank et al. (Burbank). This rejection is deemed to be improper as Burbank is not prior art under § 102(b) as it at best is only entitled to a 1999 priority date whereas the current application with the amendment to claim 49 is entitled to a September 16, 1994 priority date.

Claim 49 also stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,741,198 to Burton (Burton). Claim 49 now recites a plurality of small beads or pellets of radiodense material deployed as a marker disposed within the inner lumen. This structural limitation

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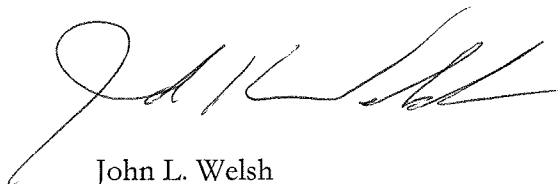
is not disclosed by Burton. Burton even fails to disclose marker material. Thus, the rejection based upon Burton is deemed to be improper.

More specifically, Burton discloses a radiopaque ferrofluid, which is injected to increase the radiopaqueness of body systems where there is slow flow of fluids, to permit radiological examinations by creating a contrast during X-ray procedures. In particular, the ferrofluid of Burton is injected into the spinal column and then is moved up and down the spinal column via a magnetic force to desired areas along the spinal column while taking radiographic images of the desired areas. A highly important aspect of Burton is that once the radiographic examination is completed, the ferrofluid is removed. The ability to completely remove the ferrofluid, thereby avoiding patient discomfort, is Burton's advancement over the prior art. As such, it is evident that ferrofluid of Burton is not used to mark a desired site for relocation and thus does not function as a marker as claimed. With the forgoing in mind, Burton fails to show or disclose various limitations of claim 49 and thus is improperly relied upon in creating a § 102 rejection.

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It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact Applicants' representative at the below number.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John L. Welsh', with a long, sweeping horizontal line extending to the left.

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